

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

(Attorney Docket No. 14275US02)

In the Application of:

Jeyhan Karaoguz, et al.

Electronically Filed on 17-JUL-2007

Serial No. 10/675,076

Filed: September 30, 2003

For: METHOD AND SYSTEM FOR
TV INTERFACE FOR
COORDINATING MEDIA
EXCHANGE WITH A MEDIA
PERIPHERAL

Examiner: John Moore Frink

Group Art Unit: 2142

Confirmation No. 5075

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The Applicant requests review of the final rejection in the above-identified application, stated in the final Office Action mailed on April 18, 2007 (hereinafter, the Final Office Action) with a period of reply through July 18, 2007. The Applicant also requests review of the arguments stated on page 2 of the Advisory Office Action mailed on June 28, 2007 (hereinafter, the Advisory Office Action). No amendments are being filed with this request.

This request is being filed with a Notice of Appeal. The review is being requested for the reasons stated on the attached sheets.

REMARKS

The present application includes pending claims 1-30, all of which have been rejected. Claims 1-2, 4, 8-9, 11-12, 14, 18-19, and 21-24 stand rejected under 35 U.S.C. 112, second paragraph. Claims 1-30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over ReplayTV 4000 User Guide, published by SONICblue Incorporated (hereinafter, SONICblue), in view of US Patent Publication 2002/0006161 of Van Der Schaar ("Van Der Schaar"). The Applicant respectfully traverses these rejections at least based on the following remarks.

I. **Rejection of Claims 1-2, 4, 8-9, 11-12, 14, 18-19, and 21-24 under 35 U.S.C. § 112**

The December 22, 2006 Office Action states the following:

The term "television" in claims 1, 2, 4, 8, 9, 11, 12, 14, 18, 19, 21 - 24, and 27 - 30 is used by the claim to mean a device capable of "controlling devices . . . and generating at least one command that causes the delivery of media" and further "controlling the delivery of the media" (pg. 4 and 5), while the accepted meaning is "an electronic device that receives television signals and displays them on a screen" (as defined by wordnet.princeton.edu). The term is indefinite because the specification does not clearly redefine the term.

See the December 22, 2006 Office Action at page 3. Apparently the Examiner is relying on the use of the term "television" in the specification and alleges that it requires clarification. The Applicant respectfully disagrees with this rejection. The test for whether claim language is sufficiently definite to be patented is as follows:

The requirements for clarity and precision must be balanced with the limitations of the language and the science. **If the claims, read in light of the specification, reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the statute (35 U.S.C. § 112, second paragraph) demands no more.**

See § 2173.05(a) MPEP (emphasis added). Furthermore, the MPEP states:

Consistent with the well-established axiom in patent law that a patentee or applicant is free to be his or her own lexicographer, a patentee or applicant may use terms in a manner contrary to or inconsistent with one or more of their ordinary meanings **if the written description clearly redefines the terms.**

See *id.* (emphasis added). The relevant statute, 35 U.S.C. § 112 ¶ 2 (1988), requires that the claims "particularly [point] out and distinctly [claim] the subject matter which the applicant regards as his invention." The operative standard for

determining whether this requirement has been met is "whether those skilled in the art would understand what is claimed when the claim is read in light of the specification."

With regard to the use of the term "television" and its associated functionalities as described in the specification, the Applicant respectfully disagrees and submits that the specification is sufficiently clear and no further clarification is required. The term "television" and its associated functionalities, as recited in the claims, is clearly defined in the specification. For example, the Examiner is referred to Figure 1 and corresponding paragraphs 28-49 or Figures 9A-9B and corresponding paragraphs 93-98, where **it is clearly explained that a television may be used in connection with, for example, a media processing system (such as, for example, MPS 116 in Figure 1 or MPU 904 in Figure 9A), providing for user interface functionality, distributed storage functionality, networking functionality, and control and monitoring of media devices (please see paragraph 30 or paragraph 95, for example).** Therefore, the Applicant submits that the use of the term "television", when interpreted in light of the specification and the figures, is sufficiently clear and readily understandable to a person ordinarily skilled in the art upon review of this specification. At least for the above reasons, the Applicant submits that the rejection under 35 USC § 112 should be withdrawn.

II. Rejection of Independent Claims 1, 11, 21, and 27 under 35 U.S.C. §103(a)

With regard to the rejection of independent claim 1 under 103(a), the Applicant submits that the combination of SONICblue and Van Der Schaar does not disclose or suggest the limitation of "controlling communication of the media from a television within a media processing system, **without consuming the media by said television,**" or "transferring the media from a first location to at least a second location **according to said controlling communication by said television**", both as recited by the Applicant in independent claim 1 (emphasis added).

Referring to the Final Office Action at pages 2-3, the Applicant points out that the **Examiner has mis-characterized the SONICblue reference by alleging that SONICblue relates to a DVR and a television.** There is absolutely no support for this assertion by the Examiner as SONICblue **relates only to a DVR.** The SONICblue reference is a User Guide for a "ReplayTV" digital video recorder (DVR). The ReplayTV DVR is also featured at www.replayTV.com. The Applicant also points out that the SONICblue document discloses only functionalities provided by the ReplayTV DVR, with **all media processing and media communication functionalities being controlled by the DVR and not by a TV.** In fact, **the SONICblue reference does not disclose a TV that controls any media communications, including transfer**

or exchange of media between two locations, without consuming the media. Even though the SONICblue document discloses network functionalities for the ReplayTV DVR (See SONICblue, at page 55), the communication of media is achieved via the DVR and not via a TV. Therefore, the Applicant maintains that SONICblue does not disclose or suggest at least the limitation of “controlling communication of the media from a television within a media processing system, without consuming the media by said television,” or transferring the media from a first location to at least a second location according to said controlling communication by said television, both as recited by the Applicant in independent claim 1.

As stated above, the Examiner is erroneously asserting that SONICblue relates to both a DVR and a television. The Examiner then relies on Van Der Schaar and alleges that, somehow, “said digital video recorder device and said television are combined into one device, resulting in said controlling communication being by said television.” Assuming for the sake of argument that SONICblue relates to a DVR and a TV (which it does not), the Applicant submits that Van Der Schaar does not overcome the deficiencies of SONICblue.

In the Final Office Action and the Advisory Office Action, the Examiner continues to rely on Figure 8 and paragraph 0045 of Van Der Schaar, which states in relevant portions:

FIG. 8 shows an exemplary embodiment of a system 800 which may be used for implementing the principles of the present invention. System 800 may represent a television, a set-top box, a desktop, laptop or palmtop computer, a personal digital assistant (PDA), a video/image storage device such as a video cassette recorder (VCR), a digital video recorder (DVR), a TiVO device, etc., as well as portions or combinations of these and other devices. System 800 includes one or more video/image sources 801, one or more input/output devices 802, a processor 803 and a memory 804.

See Van Der Schaar at paragraph 0045. Even though Van Der Schaar discloses that the system 800 may represent a combination of devices, **Van Der Schaar, including Figure 8 and paragraph 0045, does not disclose that a digital video recorder device and a television are combined into one device**, as erroneously stated by the Examiner. **In fact, the system 800 is not a single device but, rather, a combination of many devices**, as may be seen from the last sentence of the above citation from paragraph 0045 of Van Der Schaar. Even if we assume for the sake of argument that Van Der Schaar discloses a TV and a DVR combined into a single device (which Van Der Schaar clearly does not disclose), there is still no support in Van Der Schaar for “controlling communication of the media from a television within a media processing system, without consuming the media by said television,” as recited by the Applicant in independent claim 1.

Accordingly, the Applicant maintains that the combination of SONICblue and Van Der Schaar does not disclose or suggest the limitation of “controlling

communication of the media from a television within a media processing system, without consuming the media by said television,” or “transferring the media from a first location to at least a second location according to said controlling communication by said television”, both as recited by the Applicant in independent claim 1.

Independent claims 11, 21 and 27 were rejected under a similar rationale, based on the combination of SONICblue and Van Der Schaar. Since independent claims 11, 21 and 27 are similar in many respects to the method disclosed in independent claim 1, the Applicant submits that independent claims 11, 21 and 27 are also allowable over the references cited in the Final Office Action at least for the reasons stated above with regard to claim 1.

III. Conclusion

The Applicant respectfully submits that claims 1-30 of the present application should be in condition for allowance at least for the reasons discussed above and request that the outstanding rejections be reconsidered and withdrawn. The Commissioner is authorized to charge any necessary fees or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Respectfully submitted,

Date: 17-JUL-2007

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